

Serial No. 09/699,303
Third Amendment After Final
June 3, 2004

REMARKS/ARGUMENTS

Claims 17, 22, 24, 26, 29-33, 39, 43 and 45 remain in the present application. Claims 17-24, 31, 32, 33, 39 and 43 are currently amended to:

- Indicate that the deinking composition added to the wash stage is a composition whose active ingredients consist of the alkoxyates of the present invention.
- Indicate that the deinking composition is solid at room temperature. Support for this limitation is contained on page 7, lines 15 et seq. of the specification.
- Limit the size of the R group and the numbers of ethoxy and propylene oxide moieties. Support for the added limitations are contained in the specification on page 5, lines 1 et seq., and page 10.

Applicant reserves the right to file one or more divisional/continuation applications directed to subject matter canceled by this amendment.

During their conversation on May 27, the Examiner indicated a willingness to look more favorably on the claims of the present application if they were amended to indicate the claimed composition "consisted of" the ethoxyates of the present invention. Applicants have amended the claims accordingly, and respectfully submit that this is yet another reason for distinguishing the Calmanti reference (U.S. 4,360,439) cited in the Office Action mailed January 2, 2004. The Calmanti reference recites a deinking composition that includes alkoxyates, fatty acid salts, and anionic surfactants, and plainly is not covered by the pending claims.

The use of a solid deinking composition also is also significant. This limitation is nowhere taught by the cited prior art for these types of compositions. In addition, the fact that this composition has achieved commercial success, despite the difficulty of handling a solid composition, is unexpected and proves the nonobviousness of the claimed invention.

Applicants have previously shown that none of the art of record in this case discloses the use of the deinking composition of the present invention (with a large R group, a high degree of ethoxylation, and a low degree of propylene oxidelation) that is used for wash deinking (in contrast to flotation deinking). The relative size of these three constituents in one surfactant is unique when used in wash deinking processes. In his Advisory Action, the Examiner notes that the language "consisting essentially of" would not preclude the inclusion of well known deinking

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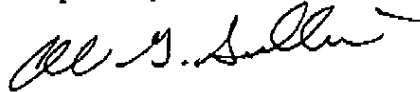
surfactants. The inclusion of the term "consisting of" hopefully obviate's the Examiner's concern.

Lastly, Applicants note the unexpected superior results achieved by their claimed compositions over the prior art. As the examples show, the residual ink content (a/k/a "ERIC") in pulp treated by the compositions of the present invention is remarkably lower than the residual ink content in pulp treated by prior art compositions. None of the prior art compositions achieved ERIC values below 300 ppm, whereas the compositions of the present invention uniformly achieved ERIC values in the 200 ppm range. These results were surprising and unexpected and further prove the nonobviousness of the claimed invention.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 11-0980.-

Respectfully submitted,



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